FILE COPY

Office Supreme Court, U.S.
FILED
MAY 23 1960
JAMES R. BROWNING, Clerk

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1959.

## No. 940

CRANE PACKING COMPANY, A CORPORATION, BETH BERNICE GREEN, INDIVIDUALLY AND AS EXECUTRIX OF EARL J. BULLARD, DECEASED, AND RONALD EUGENE GREEN AND JANIS LEANORE GREEN, MINORS, BY BETH BERNICE GREEN, THEIR NEXT FRIEND,

*Petitioners,*

*vs.*

SPITFIRE TOOL & MACHINE CO., INC., A CORPORATION,

*Respondent.*

## RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

CLARENCE E. THREEDY,
111 West Washington Street,
Chicago 2, Illinois,
*Attorney for Respondent.*

EDWARD C. THREEDY,
111 West Washington Street,
Chicago 2, Illinois,
*Of Counsel for Respondent.*

THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

# INDEX.


| | PAGE |
|---|---|
| Re Petitioners' Statement | 2 |
| Argument | |
| Re Petitioners' Reasons Assigned for the Granting of the Petition under Question 1 | 6 |
| Re Petitioners' Reasons Assigned for the Granting of the Petition under Question 2 | 10 |
| Conclusion | 13 |


## CITATIONS.

### *Cases.*


| | |
|---|---|
| American Sign & Indicator Corp. v. Edward J. Schulenberg et al., cert. den. 361 U. S. 886 | 10 |
| Busell Trimmer Co. v. Stevens, 137 U. S. 423 at 433 | 11 |
| Century Industries, Inc. v. Wieboldt Stores, Inc. et al., cert. der. 359 U. S. 1010 | 10 |
| Detrola Corp. v. Hazeltine Corp., 313 U. S. 259 at 269 | 11 |
| Dixie-Vortex Co. v. Paper Container Co., 130 F. 2d 569 at 572 (CA 7) | 11 |
| Eagle et al. v. P & C Hand Forged Tool Co., 74 F. 2d 918 at 920 (CA 9) | 11 |
| Forsythe, Caroline M. v. City of Hammond et al., 166 U. S. 506, 514-515 | 6 |
| Graver Tank & Mfg. Co. v. Linde Air Products, 336 U. S. 271, 274, 275 | 10 |
| Great Atlantic & Pacific Tea Co. v. Super Market Equipment Corp., 340 U. S. 147 | 11 |

Hamilton-Brown Shoe Co. v. Wolf Bros. & Co., 240 U. S. 251 ..... 6

Keller v. Adams, 264 U. S. 314 at 319 ..... 7

Layne v. Western Wells, 261 U. S. 387 ..... 6, 7

Lyman Gun Sight Corp. v. Redfield Gun Sight Corp., 87 F. 2d 26 at 28, Par. (CA 10) ..... 11

Thompson Co. v. Ford, 205 U. S. 445 at 447 ..... 7

*Texts.*

Corpus Juris Secundum, Vol. 69, Sec. 182(b) ..... 7

*Statutes.*

Title 35 U. S. C.

Sec. 102(b) ..... 8, 9

Sec. 103 ..... 11, 12

Sec. 251 ..... 8

Sec. 252 ..... 9

*Congressional Committee Reports.*

Senate Judiciary Committee Report re 43 Stat. 936 .... 6

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1959.

---

**No. 940.**

---

CRANE PACKING COMPANY, A CORPORATION, BETH BERNICE GREEN, INDIVIDUALLY AND AS EXECUTRIX OF EARL J. BULLARD, DECEASED, AND RONALD EUGENE GREEN AND JANIS LEANORE GREEN, MINORS, BY BETH BERNICE GREEN, THEIR NEXT FRIEND,

*Petitioners,*

*vs.*

SPITFIRE TOOL & MACHINE CO., INC., A CORPORATION,

*Respondent.*

---

## RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI.

---

*To the Honorable Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:*

MAY IT PLEASE YOUR HONORS:

This is Respondent's Brief in opposition to the Petition for Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit, seeking to review the decision of the Court of Appeals (Pet. App. 36) affirming the judgment of the trial court (Pet. App. 26).

Prior to filing the Petition herein, petitioners sought no rehearing in the Court of Appeals and by their petition

herein do not seek to have reviewed by this Court the question of invalidity of reissue claims 11 to 14 inclusive for lack of invention over the prior art which was included (Pet. App. 34) in the judgment affirmed (Pet. App. 43) by the Court of Appeals.

**RE PETITIONERS' STATEMENT.**

Petitioners' statement (pp. 3-8) falls short of being complete. It contains statements unsupported by the record. In several instances it is so worded as to be confusing and misleading. Petitioners' statement (p. 3) addressed to "Facts re Question 1," gives the impression that the only grounds that reissue claims 11 to 14 inclusive were held invalid was because of public sale and use. Such was not the case. The trial court in addition found and concluded (Pet. App. 34):

> "• • • Claims 11 to 14, inclusive, invalid for lack of invention and anticipation in view of Roshong patent No. 2,627,144; Morton patent No. 1,691,120; and Desenberg patent No. 2,352,146."

Such finding was not disturbed by the Court of Appeals. The judgment of invalidity of such reissue claims for lack of invention stands affirmed (Pet. App. 43) and is not challenged by the petitioners.

Petitioners do not make it clear that the trial court found and concluded (Pet. App. 31) reissue claims 1 to 4, 9 and 10 to be invalid as being *a mere aggregation* of a number of old parts or elements which in their aggregation perform or produce no new or different function or operation than that heretofore performed or produced by them. The trial court concluded (Pet. App. 31) that the result obtained was obvious, expected and merely an improvement over an old result and as such it was not patentable. Of such

findings and conclusions of the District Court, the Court of Appeals in its decision (Pet. App. 41) found that:

> "The findings and conclusions of the District Court in connection with reissue claims 1 to 4, inclusive, and 9 and 10 are supported by *substantial evidence.*" (Emphasis briefwriter's.)

While petitioners complain of the holding of invalidity of the reissue claims in issue, they failed to adduce any testimony with respect to the prior art patents and the question of obviousness. Such testimony *was adduced solely by respondent* (R. 334 *et seq.*; 385). This notwithstanding that petitioners had present at the trial two expert witnesses (R. 278, 289).

Nowhere in their petition do petitioners call attention to the fact that with reference to the presumption of validity urged by petitioners, the trial court said (Pet. App. 34):

> "I am aware of the presumption of validity which attaches to a patent, Title 35 U. S. C. Sec. 282, but concluded in this case that such presumption 'was overcome by clear and convincing evidence on the part of the defendants . . . .'"

In holding reissue claims 1 to 4 inclusive and 9 to 14 inclusive invalid for lack of invention the trial court said (Pet. App. 35):

> "Though plaintiff's device represents an improvement, it is clear that from one or more related prior art patents, one having ordinary skill in the art would find the claimed invention obvious."

In holding reissue claims 11 to 14 inclusive further invalid because of public use and sale, the trial court said (Pet. App. 32):

> "It follows from the above Sections that a reissue patent has to relate back to the filing date of the application for the original patent in order to avoid the consequence of public use and sale. To relate back to

the filing date of the application for the original patent, the reissue patent must constitute a continuation of the original patent. In order for the reissue patent to be a continuation of the original patent and thereby relate back to the filing date of the application for the original patent, the claims of the reissue patent must be identical to the claims of the original patent.

I hold that reissue Claims 11 to 14, inclusive, are not identical with any claim of the original patent; that they are not a continuation of the application on which the original patent issued; that they do not relate back to the filing date of the application for the original patent but are to be computed from July 25, 1953 on the question of public use and sale.

Since the evidence demonstrates that the device of reissue Claims 11 to 14, inclusive, was on sale and in use more than one year prior to July 25, 1953, I hold reissue Claims 11 to 14, inclusive to be invalid."

The order entered by the Court of Appeals in this case affirmed (Pet. App. 43) the entire judgment of the District Court (Pet. App. 26-35). In affirming such judgment the Court of Appeals as to the invalidity of reissue claims 11 to 14 inclusive said (Pet. App. 43):

"We agree with the District Court's conclusion that although a reissue application enlarging claims *may be filed within two years from the grant of the original patent*, it is, nevertheless, subject to the conditions proscribed by § 102 (b) which are by reference incorporated in § 251. The District Court did not err in holding § 102 (b) applicable and that claims 11 to 14, inclusive, were invalid because of public use and sale of Bullard's commercial device more than one year prior to the application for the reissue patent. And such holding is harmonious with the provision of 35 U. S. C. A. § 252 that a reissue patent 'to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent'. Claims 11 to 14, inclusive, are not identical with any claim of the original patent." (Emphasis by brief writer.)

Petitioners in an endeavor to minimize the importance of the prior art patents, consistently refer to the apparatus of the patent in suit as a "lapping machine". The specification of the patent in suit (R. 702, col. 3, par. 3) describes the function of the machine

> "As shown in Fig. 2, work is adapted to be positioned on the lap surface for the purpose of grinding the work." (See also R. 701, col. 1, Par. 1-2.)

In the petitioners' Statement (p. 5) they emphasize the alleged commercial success of the commercial machine of petitioner Crane. In the trial court the petitioners made no attempt to show that the alleged commercial success was due to the patented structure. On the contrary, the evidence adduced by respondent in the trial court conclusively established that petitioner Crane's commercial machine (Pl. Ex. 12, R. 286) embodied many important *unpatented* features (R. 523-540) as well as important features covered by patents *other than* the reissue patent in suit (R. 399; 773). In addition, such evidence clearly established that the licenses (R. 281) referred to by petitioners (p. 5) were entered into by the licensees under threat of suit for infringement and several of the licenses included a patent *not* here involved.

It is further emphasized by petitioners (p. 6) that the patented device permits the machine automatically to maintain a flat, convex or concave surface on the lap plate. The specification of the reissue patent (R. 702-703) describes this as being accomplished by adjusting the wear ring 61 radially upon the lap so that the wear ring will overlie either the inner or outer periphery of the lap surface. However, *no one* of the reissue claims 1 to 4, 9 and 10 (R. 703-704) includes any limitation that the wear ring overlaps either the outer or inner peripheral edge of the lap. In fact, none of such claims defines the lap as having an inner and outer periphery.

## ARGUMENT.

### RE PETITIONERS' REASONS ASSIGNED FOR THE GRANTING OF THE PETITION UNDER QUESTION 1.

The decisions are legion and uniform with respect to the attitude of this Court regarding the granting of petitions and directing the issuance of writs of certiorari.

As stated by Justice Pitney in *Hamilton-Brown Shoe Co.* v. *Wolf Bros. & Co.*, 240 U. S. 251:

> "As has been many times declared, this is a jurisdiction to be exercised sparingly, and only in cases of peculiar gravity and general importance, or in order to secure uniformity of decision."

See also *Layne Power Corp.* v. *Western Wells*, 261 U. S. 387; *Caroline M. Forsythe* v. *City of Hammond et al.*, 166 U. S. 506, 514-515.

The report of the Senate Judiciary Committee, recommending the passage of the Act of February 13, 1925 (43 Stat. 936) said:

> "The central thought is this, that litigants have, first, a trial in the district court, and then by appeal or writ of error, a trial in the Circuit Court of Appeals—a court that ranks as high or higher than the supreme tribunals of the states. It is our belief that here ordinary litigation should end, and that the cases should not go to the Supreme Court of the United States unless the questions involved are of grave public concern, or unless serious uncertainty attends the decision of the Circuit Court of Appeals by reason of conflict in the rulings in these courts or the courts of the States."

There is no conflict of decisions between Courts of Appeals on the issues decided by the Court of Appeals in

this case. *Keller* v. *Adams*, 264 U. S. 314 at 319; *Layne v. Western Wells*, 261 U. S. 387, 393. The decisions of the trial court and the Court of Appeals in this case are harmonious, both courts having uniformly sustained respondent's contention without dissent. This Court has consistently refused to review concurring holdings of lower tribunals: *Thompson Co.* v. *Ford*, 205 U. S. 445 at 447.

The concurring decisions of the trial court and the Court of Appeals in this case did not hold that the 1952 Patent Act made a sweeping and vital change in the law relative to reissue patents as it had been interpreted and applied by the courts for more than a century, as contended by petitioners (p. 10, par. C) as grounds for the allowance of their petition.

Both the trial court and the Court of Appeals decided, among other things, what effect public sale and use more than five years prior to the filing of the reissue application, had upon reissue claims 11 to 14 inclusive where it was admitted that such claims were not identical to those of the original patent, with the consequence that as to reissue claims 11 to 14 the reissue patent by reason of such lack of identity *was not a continuation* of the original patent and entitled to the benefit of the filing date thereof.

In deciding such question, the Court of Appeals did precisely what petitioners point out (p. 13) should be done in the interpretation of a statute, to-wit, that statutes should be construed in such manner as to give effect to every word and provision.

While the 1952 Patent Act in and of itself clearly supports the findings and conclusions of the courts below with respect to reissue claims 11 to 14, of interest is Volume 69, *Corpus Juris Secundum*, Section 182(b). There it is stated with supporting authority that:

"A reissue patent as to identical claims carried from

the original patent on the question of anticipation and public use and sale, relates back to the date of the original application for patent."

Conversely, a reissue patent as to claims *not* identical to or carried over from the original, on the question of anticipation and public sale and use, does not relate back to the date of the original application for patent.

The Court of Appeals in this case, as did the trial court, read that part of Section 251 (Title 35 U. S. C.), to-wit, "The provisions of this title relating to applications for patent shall be applicable to applications for reissue patent", in the light of Section 102(b). Such courts concluded that inasmuch as the provisions of Title 35 relating to applications for patent are made applicable to applications for reissue patents, Section 102(b) having to do with the public sale and use bar was, as in the case of original applications, applicable to reissue applications. In so holding the courts below in this case did not, as petitioners contend (p. 10, par. B), nullify the provision of the last paragraph of Section 251 which permits the reissue of an original patent within two years from the date thereof for the purpose of enlarging the claims of the original patent.

In erroneously characterizing Question 1 as of public importance (p. 8 *et seq.*), petitioners assume that the decision of the Court of Appeals in this case invalidates all reissue patents issued since the passage of the 1952 Patent Act. The concurring decisions of the trial court and the Court of Appeals in this case did *not* hold that a patentee could not, under the 1952 reissue statute, reissue his patent for the purpose of enlarging the scope of the claims thereof. On the contrary, the concurring decisions of the trial court (Pet. App. 31-32) and the Court of Appeals (Pet. App. 43) in this case, both held, and rightly so, that a patentee may reissue his original patent within two years from date thereof (Sec. 251, 35 U. S. C.) for such purpose as long

as he has not put the invention covered by the broadened claims into public use and sale; if he has done so, he still can apply for such reissue for such purpose provided he does so within one year of the first occurrence of said public use and sale (Sec. 102b).

As pointed out by the Court of Appeals (Pet. App. 43) in this case, its holding that public use and sale is applicable to reissue patents

> "is harmonious with the provisions of 35 U. S. C. A. § 252 that a reissue patent 'to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent'."

In petitioners' argument (p. 13) that the opinion of the Court of Appeals violates canons of statutory construction in at least two respects, it is significant to note that petitioners have omitted from their quotation on page 13 significant language of Section 252 (35 U. S. C.) reading:

> "but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent [claims 11 to 14 incl. here in issue are not identical with the original], shall constitute a continuation thereof and have effect continuously from the date of the original patent."

The portion of Section 252 omitted by petitioners on page 13 and which they choose to ignore, renders petitioners' argument untenable.

Respondent believes and respectfully submits that where there is no conflict of decisions and where, as here, the decisions of the Court of Appeals and the trial court are concurring, and where no showing has been made that such decisions are contrary to the statute in question, it is not

sufficient for petitioners to urge as a grounds for writ of certiorari that a Federal question is involved.

Respondent respectfully submits that under Question 1 of the petition, the reasons assigned by petitioners do not justify the granting of their petition; that the petition has for its primary purpose an atttempt to obtain through the Supreme Court of the United States a third trial of the issues. If petitioners were of the opinion that the Court of Appeals erred in its decision with respect to the invalidity of reissue claims 11 to 14 inclusive because of prior public use and sale, petitioners were privileged under the rules of the Court of Appeals to have applied for a rehearing by that court. This they did not do. They should not be permitted to seek that rehearing in this Court.

**RE PETITIONERS' REASONS ASSIGNED FOR THE GRANTING OF PETITION UNDER QUESTION 2.**

Question 2 (p. 2) is purely a factual question. *Graver Tank & Mfg. Co.* v. *Linde Air Products,* 336 U. S. 271, 274, 275. Questions of such type have been repeatedly held by this Court as not justifying the granting of a petition for writ of certiorari. *American Sign & Indicator Corp., Petitioner* v. *Edward J. Schulenberg et al.,* Respondents, No. 380, October Term 1959 (cert. den. 361 U. S. 886; opinion below 267 F. 2d 388); *Century Industries, Inc.* v. *Wieboldt Stores, Inc. et al.,* No. 847 (cert. den. 359 U. S. 1010; opinion below 263 F. 2d 934).

The decisions of this Court, the Courts of Appeal, and the District Courts, are legion and uniform with respect to the proposition that in connection with the issue of *lack of invention,* it is not necessary that the claimed invention be found in one single patent or publication—it is enough to show that from one or more related prior art patents, one having ordinary skill in the art would

find the claimed invention obvious. *Detrola Corp.* v. *Hazeltine Corp.*, 313 U. S. 259 at 269; *Busell Trimmer Co.* v. *Stevens*, 187 U. S. 423 at 433; *Dixie-Vortex Co.* v. *Paper Container Co.*, 130 F. 2d 569 at 572 (CA 7); *Eagle et al.* v. *P & C Hand Forged Tool Co.*, 74 F. 2d 918 at 920 (CA 9); *Lyman Gun Sight Corp.* v. *Redfield Gun Sight Corp.*, 87 F. 2d 26 at 28, Par. 4 (CA 10). (See Sec. 103, below.)

The decisions of the trial court and Court of Appeals with respect to the invalidity of reissue claims 1 to 4, 9 and 10 (Pet. App. 31) as well as the trial court's decision with respect to the invalidity of reissue claims 11 to 14 inclusive for lack of invention over the prior art (Pet. App. 34-35), are consistent with Section 103 (Title 35 U. S. C.) that:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *"

In applying Section 103, the Court of Appeals (Pet. App. 41) rightly held that:

> "It is enough to defeat a patent under 35 U. S. C. A. § 103 that from one or more related prior art patents, one having ordinary skill in the art would find the claimed invention obvious."

Such holding is in conformity with this Court's decision in *The Great Atlantic & Pacific Tea Company* v. *Super Market Equipment Corp.*, 340 U. S. 147 (see also decn. Pet. App. 41).

The criticism by petitioners (p. 16) that the Court of Appeals showed a lack of understanding of the limits of *The Great Atlantic & Pacific Tea Company* case is unimpressive and uncalled for.

The statement by petitioners (p. 17) as a further grounds for the granting of their petition, that the Court of Appeals did not understand the purpose and function of the Morton patent (R. 727-731), is likewise unimpressive and wholly unsupported. Significant is the fact that petitioners, who now complain of the alleged lack of understanding by the courts below of the Morton patent, *in no single instance* adduced any testimony relative to such patent or, as a matter of fact, to any of the prior art patents upon which the trial court found reissue claims 1 to 4 and 9 to 14 inclusive invalid for lack of invention because the invention was obvious, as that term is used in Section 103 (Title 35 U. S. C.).

In urging allowance of their petition, petitioners emphasize the statutory presumption of validity but fail to point out to this Court that the trial court after a studious examination of the prior art, exhibits, and demonstrations thereof, and the testimony adduced solely by respondent, stated in its decision (Pet. App. 34) that:

> "I am aware of the presumption of validity which attaches to a patent, Title 35 U. S. C. Sec. 282, but concluded in this case that such presumption was '*overcome by clear and convincing evidence on the part of defendants*'." (Italics by brief writer.)

The contentions advanced by petitioners (p. 15-19) re Question 2 are entirely without merit and do not constitute justification for the granting of their petition.

## CONCLUSION.

It is respectfully submitted that the petition for writ of certiorari should be denied.

Respectfully submitted,

SPITFIRE TOOL & MACHINE CO.,
*Respondent,*
By CLARENCE E. THREEDY,
*Its Attorney.*

EDWARD C. THREEDY,
*Of Counsel for Respondent.*